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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,217	07/02/2001	Nobuyuki Tanaka	204080/00	8539

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EXAMINER	
PATEL, SHEFALI D	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/895,217	TANAKA, NOBUYUKI	
	Examiner	Art Unit	
	Shefali D. Patel	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-10,16-20 and 22-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-10,16-20 and 22-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment was received on 14 March 2006.

2. Claims 1-5, 11-15 and 21 are previously canceled.

3. Claim 24 is newly added.

Response to Arguments

4. Applicant's arguments filed on 14 March 2006 (Remarks, pages 5-6) have been fully considered but they are not persuasive.

Applicant argue on page 5 stating "Ryan does not show or suggest detecting the electronic watermark along with the value of bit data for which is defined a plurality of instructions, and performing a processing according to the instruction obtained from a table file which includes instructions for different values of the bit data."

The examiner respectfully disagrees.

The examiner believes that she never claimed Ryan disclosing detecting the electronic watermark along with the limitation recited by the applicant in the argument stated above. Please see pages 2-3 paragraph 2 of the previous office action mailed on 10 January 2006. The examiner states that Ryan discloses a table file defining instructions corresponding to bit-data included in the watermark as seen in Figure 3 and explained at respective portions in the specification. The examiner admits that Chung discloses detecting a watermark from an image as stated in the previous office action.

Applicant further argues on page 5 stating "...there is no table file of instructions paid to values of bit data where one of those instructions is then performed [by Ryan]" (emphasis added by the examiner).

The examiner disagrees. Please note that when the bits are detected the WM type is detected, therefore, if it is found that the WM type detected is 'copy-once' then copying is permitted only once (or when 'copy-once' is detected). Hence, the instructions are being performed. See, col. 9 lines 19-21.

Applicant argues on page 6 stating "Chung does not make up for any of the deficiencies of Ryan. Rather, Chung is related to encoding and decoding watermarks in MPEG pictures, and does not show detecting the electronic watermark along with the value of bit data for which is defined a plurality of instructions, and performing a processing according to the instruction obtained from a table file which includes instructions for different values of the bit data, or using the eight bit data as the watermark and bit data being four bit data in the low order four bits of the electronic watermark."

The examiner again respectfully disagrees.

First, nowhere in any independent claims (at least) there is a mention of "using the eight bit data as the watermark and bit data being four bit data in the lower order four bits of the electronic watermark." Second, even if there was any (claim 7), Ryan discloses this at col. 4 lines 26-28, 39-42 and col. 5 lines 22-29. Also, Chung discloses detecting a watermark at col. 8 lines 51-59 and Figure 6 elements 242 and 224.

It is important to remember the combination of these two references to meet the limitation of claim 6, for example. The motivation for doing so is to improve economics and security over the exiting art as suggested by Ryan and to prohibit one from copying more than once as disclosed by Ryan at col. 2 lines 15-27. Therefore, it would have been obvious to combine Chung with Ryan to obtain the invention as specified in claim 6. Please note that the watermark includes bit-data by Chung at col. 6 lines 32-60.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 6-10, 16-20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al. (US 6,310,962) (hereinafter, "Chung") in view of Ryan, et al. (US 6,374,036) (hereinafter, "Ryan").

With regard to **claim 6** Chung discloses a device that detects an electronic watermark which includes bit-data from a compressed original image (Figure 6 and col. 5 lines 63-67), comprising: a circuit which reads the compressed original image data (reading/inputting MPEG2 moving pictures as seen in Figure 6); a circuit which decodes said compressed original image to produce a decoded data (watermark remover 242, col. 8 lines 48-51); a circuit which performs inverse discrete cosine transform (IDCT) for said decoded data (IDCT 224, col. 8 lines 51-59); a circuit which detects electronic watermark data embedded in data for which IDCT has been performed along with the value of said (*bit-data*) for which is defined a plurality of instructions (VLC & MUX 236 to output encoding bitstream, Figures 6 and 7, col. 9 lines 4-32). Chung does not expressly disclose a table file including one of said instructions for said value of said bit-data; and having a circuit which performs a processing according to said instruction in said table file. Ryan discloses the watermark containing instruction such as "copy-once," "copy-never," "copy no more," etc. at col. 4 lines 33-36, 64-66, col. 5 lines 22-29; Also see Figure 2 and its respective portions in the specification for a table file with instructions. These instructions are performed according to the electronic watermark. Ryan and Chung are combinable because they are from the same field of endeavor, i.e., watermark encoder/decoder system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Chung with Ryan. The

motivation for doing so is to offer improved economics and security over the existing art as suggested by Ryan at col. 2 lines 30-33 and to prohibit one from copying more than once as disclosed by Ryan at col. 2 lines 15-27. Therefore, it would have been obvious to combine Chung with Ryan to obtain the invention as specified in claim 6.

With regard to **claim 7** Ryan discloses the electronic watermark data as eight-bit data (col. 4 lines 26-28) and said bit-data is four-bit data (col. 4 lines 39-42, col. 5 lines 23-29).

With regard to **claim 8** Ryan discloses characters are displayed according to said instruction corresponding to said bit-data (col. 5 lines 59-62 where "copy-once," "copy-never," "copy no more," etc. is being displayed).

With regards to **claims 9-10,** it would have been obvious matter of design choice to modify Ryan's reference by having an instructions to access a website on the internet or start an application process since applicant has not discloses that having an instructions to access a website on the internet or start an application process solves any stated problem or is for any particular purpose and it appears that Ryan's invention of having instructions for "copy-once," "copy-never," "copy no more," etc. would perform equally well with having an instructions to access a website on the internet or start an application process (as disclosed in Ryan at col. 16 lines 22-25).

Claim 16 recites identical features as claim 6 except claim 16 is a method claim. Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 16.

Claim 17 recites identical features as claim 7. Thus, arguments similar to that presented above for claim 7 is equally applicable to claim 17.

Claim 18 recites identical features as claim 8. Thus, arguments similar to that presented above for claim 8 is equally applicable to claim 18.

Claims 19-20 recites identical features as claims 9-10. Thus, arguments similar to that presented above for claims 9-10 are equally applicable to claims 19-20.

Claim 22 recites identical features as claim 6 except claim 22 is a computer readable recording medium claim (Figures 6-7 of Chung). Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 22.

Claim 23 is a broad version of claim 6. Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 23.

Claim 24 recites identical features as claim 7. Thus, arguments similar to that presented above for claim 7 is equally applicable to claim 24.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shefali D Patel
Examiner
Art Unit 2624

May 1, 2006

JINGGE WU
PRIMARY EXAMINER